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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF

Inventor : John C. Yundt-Pacheco
Serial No. : 09/800,113
Filing Date : March 6, 2001
Title : METHOD AND DEVICE FOR FORMATTING
INSTRUMENTATION OUTPUT

Group/Art Unit : 2171
Confirmation No. : 2746
Examiner : Hahn B. Thai

Docket No. : HEMA.71475

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provisions of 37 C.F.R. § 41.41, Applicant submits this

Reply Brief in response to the Examiner's Answer mailed on August 11, 2005.

REMARKS

In the Examiner's Answer responding to Appellant's Supplemental Appeal Brief,
the Examiner maintains his rejection of claims 1-8 as being obvious over U.S. Patent No.
5,437,024 to French ("*French*") in view of U.S. Patent No. 6,665,081 to Suzuki et al. ("*Suzuki*").

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Appellant first refers the Board to the previously filed Appeal Brief and Supplemental Appeal Brief for more detailed responses to the Examiner's rejection. This Reply Brief will directly address the points raised in the Examiner's Answer.

I. Paragraph 11 of Examiner's Answer

In paragraph 11 of the Examiner's Answer, the Examiner states that French clearly discloses the step of "storing the formatted data in a file for extraction by the external monitoring facility".

Appellant notes that in the Office Action of September 1, 2004, necessitating Appellant's Supplemental Appeal Brief, the Examiner's rejection conspicuously omitted any claim that French disclosed the "storing" step of the present invention. Be that as it may, the Examiner now states that "French teaches at col. 19, lines 13-45 and Fig. 8 the report corresponding to the 'formatted data' contained in queue file and the print file is stored."

Appellant again notes that in the system of French, a queue file is temporarily maintained in computer memory until the printer is available to print the file (see, e.g., column 16, lines 40-56). By contrast, the system claimed in the present application requires "storing the formatted data in a file for extraction by the external monitoring facility." It is well known in the computer science art that a "queue" is a temporary, volatile holding area for data, while "file" storage is typically permanent, non-volatile storage. Thus, French discloses only a system in which reports being sent to predetermined recipients are temporarily queued until they can be printed, while the claims of the present application require storing the data in a file, to be later retrieved by an external monitoring facility.

Even assuming, *arguendo*, the system of French could respond to a request from an external monitoring facility, as in the invention claimed in the present application, there

would be no "stored" file which it could send. French simply discloses a system in which reports are automatically generated, temporarily queued, and sent to predetermined recipient printers. There is no "storage" of files in French as that term is used in the present application, and as is claimed in all of the claims of the present application.

The Examiner further states that Appellant's limitation "for extraction by the external monitoring facility" in the claims should not be given much patentable weight. Appellant again respectfully disagrees.

The Federal Circuit has stated that language, such as a whereby clause in a method claim, is not given weight when it simply expresses the intended result of a process step positively recited. *Minton v. National Association of Securities Dealers, Inc.* 67 USPQ2d 1614 (Fed. Cir. 2003). In *Minton*, the court was considering whether the whereby clause in the phrase "*whereby the security is traded efficiently between the first individual and the second individual*" offered any further limitation to the claim. The court found that "traded efficiently" was simply a laudatory characterization of the trading step, and not limiting.

That however, is not the case here. The claims of the present application require "storing the formatted data in a file for extraction by [an/the] external monitoring facility". Here, "for extraction by [the/an] external monitoring facility" language does not simply express the result of storing the data file. It expresses a particular limitation for storing the data file, namely, stored for extraction by an external monitoring facility. In distinguishing over prior art cited in the prosecution of this application, Appellant has repeatedly pointed out and argued this distinction – the stored file is extracted by an external monitoring facility.

In *Spectrum International Inc. v. Sterlite Corp.*, 49 USPQ2d 1065 (Fed. Cir. 1998), an applicant, during prosecution of the application, had argued that its crate differed from

the cited prior art in that the claimed invention did not include a merger of the bottom side of the crate with a top edge of the front wall of the crate. After issuance of a patent and pursuing an infringer, the applicant asserted that the open-ended "comprising" language in the claim allowed reading the claim to include merger of the bottom side of the crate with a top edge of the front wall of the crate. The court, of course, found that by conceding such a crate construction during prosecution, the applicant was not able to restore that subject matter by virtue of the "comprising" term used in the claim.

This case is analogous to the interpretation of the "for extraction" limitation at issue here. The Examiner states that the "for extraction" should be given little patentable weight. However, Appellant maintains that, as in *Spectrum*, the limitation in the claims is limiting, and cannot simply be disregarded in determining patentability of the claims. Similar to the situation in *Spectrum*, in order to overcome the cited prior art, Appellant here has argued that the claims are directed only to system in which the formatted data file is stored for later extraction by an external monitoring facility. As in *Spectrum International*, if attempting to enforce its claims, Appellant would clearly be limited by the "for extraction" limitation, and the arguments presented during prosecution. Appellant would not be allowed to suggest that the "for extraction by an external monitoring facility" language in the claim be disregarded in interpreting the scope of the claim. Thus, it is improper for the Examiner to construe the claims without any regard for the limiting "for extraction" phrase. Appellant has included the "for extraction" limitation in the claims, and has argued in favor of allowance of those claims such that any allowed claims will be limited in scope by that limitation and arguments. The Examiner should not be allowed to simply ignore that limitation in order to reject the claims in view of the prior

art, when that same limitation would prevent Appellant from enforcing its claims against the embodiments disclosed in that prior art.

For the foregoing reasons, Appellant submits that claims 1-8 are patentable over the cited references and should be allowed. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejections and allow claims 1-8.

Respectfully submitted,

By: 

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